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OFFICE OF PETITIONS

In re Application of :
Hernandez, Collins, Hollis, :
Schiffer, and Whitley : DECISION REFUSING STATUS
Application No. 10/700,878 : UNDER 37 CFR 1.47(a)
Filed: 4 November, 2003 :
Attorney Docket No. 026032-4626 :

This is in response to the renewed petition filed under 37 CFR 1.47(a) on 14 February, 2005.

The petition is again **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 4 November, 2003, without an executed oath or declaration. Accordingly, on 10 September, 2004, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration, a surcharge for its late filing, and replacement drawings in compliance with 37 CFR 1.84 and 1.121. In response, on 9 November, 2004, petitioners filed replacement drawings, a petition under 37 CFR 1.47(a), the petition fee and surcharge and a declaration naming Cynthia

Hernandez, Alan Collins, Marne Hollis, Charlotte Schiffer, and Roger Whitley as joint inventors and signed by joint inventors Hernandez, Collins, and Whitley on behalf of themselves and non-signing joint inventors Hollis and Schiffer. The petition was dismissed on 14 December, 2004.

The present renewed petition was filed on 14 February, 2005. Petitioners assert that a copy of the declaration was sent to each of the non-signing inventors. The letter sent to joint inventor Schiffer was returned as undeliverable, while no response was received from joint inventor Hollis. A copy of the envelope showing the letter to Schiffer was returned as undeliverable is attached.

Petitioners have provided a statement of facts by Jodi Hemmeke stating that a copy of the application papers was sent to inventors Hollis and Schiffer, and that an online search was performed to determine more recent addresses for both non-signing inventors, but that no addresses were discovered. Petitioners further assert that the original oath or declaration as filed is proper.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2).

In regards to item (2), the declaration is defective because (a) it is unclear whether all of the inventors signed a declaration naming the proper inventive entity and (b) the declaration contains is defective in that it contains non initialed and/or non-dated alterations.¹

¹See 37 CFR 1.52(c).

As stated previously, the copy of the declaration signed by Hernandez contains Collins' signature block on Page 4 of 5, while the declaration signed by Whitley contains Collins' signature block on Page 5 of 5.

MPEP 201.03 states, in pertinent part:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, *each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity.* Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declarations may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

(Emphasis added)

Additionally, as stated previously, the signature block(s) for joint inventor Collins contain alterations in that the residence city for joint inventor Collins has been altered. Additionally, the signature block for joint inventor Collins on Page 5 of 5 has a cross-out in it.

While petitioners argue that 37 CFR 1.52(c)(1) permits such an alteration as long as the applicant has signed on the same sheet of paper, MPEP 602.01 states that the wording of an oath or declaration cannot be amended, altered, or changed in any manner after it has been signed. Here, it is unclear whether the alteration was made before or after joint inventor Collins signed the declaration. As such, a new oath or declaration signed by joint inventor Collins is required. Likewise, the cross-out in the signature block for joint inventor Collins on Page 5 of 5 suggests that Collins may not be an inventor on the declaration listing Hollis, Schiffer, and Whitley as joint inventors. Therefore, the declaration does not clearly indicate what each inventor believes to be the appropriate inventive entity. As such, a new oath or declaration in compliance with 37 CFR 1.63

and 1.67, signed by all of the signing inventors on behalf of themselves and the non-signing inventors, is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petitions
 Crystal Plaza 2, Lobby, Room 1B03
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Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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